



20 SEP 2005

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In re Application of :
RAHKOMAA : DECISION
Application No.: 09/719,029 :
Filing Date: December 05, 2000 :
Attorney's Docket No.: 990.1246 :
For: EQUIPMENT AND METHOD IN A PAPER OR :
BOARD MACHINE FOR MIXING OF FRESH :
STOCK AND OF WATER FOR DILUTION OF :
FRESH STOCK :

This is in response to the applicant's "Request for Correction to Record, filed February 25, 2005.

BACKGROUND

On 27 May 1999, applicant filed international application PCT/FR99/00458, which claimed priority of an earlier Finnish application filed 05 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 October 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 December 2000.

On 05 December 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a unexecuted declaration; and the surcharge for submitting the oath or declaration later than 30 months. Additionally, the papers were accompanied by a letter entitled "SUBMISSION OF APPLICATION FOR FILING DATE WITHOUT DECLARATION." The letter stated the following: In accordance with 37 CFR 1.53(a)-(b), applicant submits herewith for assignment of a serial number and filing date the following:"

On 08 January 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating an oath or declaration was required. The Notification set a two-month period for reply.

On May 30, 2002, the United States Designated/Elected Office mailed a Notification of Abandonment indicating that the application was abandoned because applicant had failed to respond to the Notification of Missing Requirements.

On 10 July 2002, applicant filed an executed declaration.

On 26 August 2002, the United States Designated/Elected Office mailed a Notice of Acceptance of Application under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Withdrawal of Previously Sent Notice indicating the Notice mailed on 30 May 2002 was sent in error and to disregard that Notice.

On 25 February 2005 filed the present request for correction of the record.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

While the transmittal letter filed on 05 December 2000 identified the application as a national stage application being filed under 35 U.S.C. 371, applicants' reference to 37 CFR 1.53(b) in the accompanying transmittal letter filed 05 December 2000 is inconsistent with and contradicts any desire expressed in any papers filed that might have been filed to enter the national stage of the PCT under 35 U.S.C. 371. Application papers submitted under 37 CFR 1.53(b) are considered filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 05 December 2000 were improperly accepted as a filing under 35 U.S.C. 371. Since the application is deemed to have been filed under 35 U.S.C. 111(a), international application PCT/FI99/00458 is abandoned with respect to the United States.

Accordingly, all the forms issued by the United States Designated/Elected Office are hereby VACATED.

Applicant is entitled, subject to 37 CFR 1.78(a)(2)(ii), to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter,

since this application (Serial No. 09/719,029) and the international application (PCT/FI99/00458) designating the United States were copending on 05 December 2000. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/FI99/00458, filed 27 May 1999, which designated the United States and is now abandoned." Alternately, applicant may make the claim by submitting an Application Data Sheet with the continuity information completed. Applicant may need to file a petition and fee under 37 CFR 1.78(a)(3) to be entitled to make the claim.

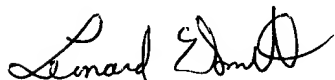
Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP 1896.

CONCLUSION

U.S. application 09/719,029 is **NOT** the national stage application of international application PCT/FI99/00458. All the forms issued by the United States Designated/Elected Office are hereby VACATED. Applicants should amend the application either by submitting an Application Data Sheet or amending the first sentence of the specification accordingly.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

This application is being returned to the Office of Initial Patent Examining for treatment of this application as an application filed under 35 U.S.C. 111(a) with a filing date of December 05, 2000.



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